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Graham R.F. Napier

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EXAMINER

SOREY, ROBERT A

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

10/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/776,079	Applicant(s) NAPIER ET AL.	
	Examiner ROBERT SOREY	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/24/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. In the amendment filed 07/01/2008, the following occurred: Claims 1, 3, 10, 17, and 20 have been amended. Claims 1-20 are presented for examination.

Response to Amendments

2. Applicant's amendments to claims 1, 3, 10, 17, and 20 are accepted as they appear to not add new matter. Furthermore, objections to claims 3, 10, 17, and 20 are withdrawn as Applicant has made appropriate changes.

Double Patenting

3. Rejection to claims 1-20 for nonstatutory obviousness-type double patenting over claims 1-24 of copending U.S. Patent Application Publication 2005/0177447 (with Application Number 10/776587) is withdrawn in light of amendments made to the copending application.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0115072 to Manucha et al. in view of U.S. Patent Application Publication No. 2002/0107785 to Melchior et al.

Art Unit: 3626

6. As per claim 1, Manucha et al. teaches a computer-aided method of collaborating on conditions to cover an international shipment from an exporter to an importer and confirming performance in accordance with the conditions, the method including:

- setting authorizations for international shipment participants to view and edit aspects of data that records the conditions covering the international shipment, tracks progress of the international shipment participants towards meeting the conditions, and conditions release of the international shipment on fulfillment or waiver of the conditions (see: paragraphs 0014-0015);

- receiving agreed conditions (see: paragraph 0016);

- receiving documentation corresponding to fulfillment of the agreed conditions (see: paragraph 0056); and

- approving release and electronically updating release status of the international shipment, following the evaluation by the exporter that agreed the conditions have been fulfilled (see: paragraphs 0056 and 0069-0070).

7. As per claim 4, Manucha et al. teaches:

- further including exposing to view by the international shipment participants status tracking information regarding establishment of the conditions for insurance coverage, the documentation of fulfillment and the approval of fulfillment, abatement or waiver of the conditions (see: paragraphs 0015 and 0016).

8. As per claim 5, Manucha et al. teaches:

--the exposed status information identifies, for particular roles, whether the particular roles are responsible to carry out a next step in the establishment of the conditions, the documentation of fulfillment or the approval of fulfillment, abatement or waiver of the conditions (see: paragraphs 0015 and 0016).

9. Manucha et al. fails to explicitly teach that the conditions of claims 1, 4, and 5 are insurance conditions; however, Melchior et al. teaches a method for collaborating on insurance conditions over a computer network in which shipment participants can negotiate, view, and edit aspects of data (see: paragraphs 0014 and 0039). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate insurance condition functionality into the system of Manucha et al. with the rationale of facilitating the integration of cargo insurance into an electronic import/export trading system (see: paragraph 0013 of Melchior et al.).

10. As per claim 2, Manucha et al. discloses the invention substantially as claimed, see discussion of claim 1, but Manucha et al. fails to specifically point out:

--authorizations to view images of documents.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Manucha et al. with the teachings of Melchior et al. (see: paragraph 0008 of Melchior et al.) with the rationale of having copies of pertinent documents available to authorized users for the purposes of providing proof of transaction in order to facilitate the early resolution of possible

Art Unit: 3626

exceptions or problems which could prevent timely payment (see: paragraph 0008 of Melchior et al.).

11. As per claim 3, Manucha et al. discloses the invention substantially as claimed, see discussion of claim 1, but Manucha et al. fails to specifically point out:

--the aspects of data further record filing of insurance claims with a policy applied to the international shipment in accordance with the insurance conditions.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Manucha et al. with the teachings of Melchior et al. (see: paragraphs 39, 149, and Appendix A page 37 - the last illustration in the Appendix) with the rational of quickly providing proof of coverage in order to facilitate the early resolution of possible exceptions or problems which could prevent timely payment (see: paragraph 0008 of Melchior et al.), electronically evaluating whether the agreed upon conditions had been fulfilled (see: paragraph 0016 of Melchior et al.), and/or having a fully integrated international goods and services transaction system (see: paragraph 0013 of Melchior et al.).

12. As per claim 6, Manucha et al. discloses the invention substantially as claimed, see discussion of claim 1, but Manucha et al. fails to specifically point out:

--including selecting standard terms for title transfer/risk allocation in shipment and assigning responsibility for procuring insurance, based on the selected standard terms.

Art Unit: 3626

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Manucha et al. with the teachings of Melchior et al. (see: paragraphs 147, 148, and 151) with the rational of making available new and valuable ways of providing and obtaining cargo insurance (see: paragraph 0147 of Melchior et al.).

13. As per claim 7, Manucha et al. teaches:

--including tracking the passage of time between steps, comparing the time passed to predetermined values, and alerting a role when excessive delay is detected (see: paragraph 0074).

14. As per claims 8-14, they are rejected for the same reasons set forth in claims 1-7, and Manucha et al. further discloses a computer aided method and system including storage and logic (see: Figs. 1-5, paragraphs 1-46).

15. As per claims 15-17, they are rejected for the same reasons set forth in claims 1-3, and Manucha et al. further discloses a computer aided method and system including storage and logic (see: Figs. 1-5, paragraphs 1-46).

Art Unit: 3626

16. As per claims 18-20, they are rejected for the same reasons set forth in claims 1-3, and Manucha et al. further discloses a computer aided method and system including storage and logic (see: Figs. 1-5, paragraphs 1-46).

Response to Arguments

17. Applicant's arguments filed on 07/01/2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed 07/01/2008.

18. *Claim 1*

- Claim 1 Applicant response: Manucha nor Melchior "discuss requirements for insurance as contract conditions".
- Claim 1 Examiner response: Applicant's argument is unpersuasive. A requirement for insurance as contract conditions is not claimed. What is claimed is a method of collaborating on insurance conditions covering an international shipment, not a contract condition requiring insurance. The combination of Manucha and Melchior in the examination of the claims on the merits found above successfully meets the limitations as claimed. Applicant attacks the references individually but is reminded in this and all other responses that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 416, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Art Unit: 3626

- Claim 1 Applicant response: "Since neither Manucha nor Melchior read on the limitations of this claim, it defies common sense for the combination of references to introduce a feature that neither reference includes. Only by use of hindsight, which is prohibited, would the Examiner go beyond the teachings of either reference and introduce a feature that is only found in these claims and not in either reference. It takes more than combining the reference."
- Claim 1 Examiner response: Applicant's opinion is appreciated but in absence of argument is found unpersuasive. Applicant is reminded in this and all other responses that arguments should point out disagreements with the Examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.
- Claim 1 Applicant response: "It takes exercise of hindsight to modify the combination of the references, before the combination would read on this claim."
- Claim 1 Examiner response: In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at

Art Unit: 3626

the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim 4

- Claim 4 Applicant response: The cited art fails to establish "conditions or instruction for insurance coverage or electronically evaluates fulfillment, abatement or waiver of the insurance conditions".
- Claim 4 Examiner response: Applicant's argument is unpersuasive. Firstly, "electronically" evaluating is not claimed. Secondly, what is claimed is exposing to view "status tracking information regarding" the elements of conditions or instructions for insurance coverage. The import/export system for supply chains, as taught by Manucha and Melchior in the cited passages, describe a display interface for maintaining and editing databases of records relating to a plurality of shipments of goods between at least two jurisdictions. The records in the databases are status tracking information, and that such information very broadly "regards" condition or instruction for insurance coverage as broadly claimed. This is supported throughout the cited references as combined in the rejections above, and furthermore, for example, Manucha, in paragraph 51, describes a "header table" database containing insurance information data.

Claim 5

Art Unit: 3626

- Claim 5 Applicant response: The cited references fail to teach “Role-oriented identification of persons responsible to carry out a next step in insurance condition establishment, fulfillment and approval of fulfillment.”
- Claim 5 Examiner response: Applicant’s argument is unpersuasive. Firstly, that “persons” are indicated as the roll-oriented entities responsible to carry out a next step is not claimed. What is claimed are “particular roles” which is very broad and interpreted - as in the cited portion of the prior art - as a “member of a supply chain”, which the prior art teaches can be “manufacturers/exporters, customers/importers, brokers, shipping organizations, freight forwarders, warehousing organizations, etc.” (see: Manucha, paragraph 9) and governments (see: Manucha, paragraph 70). Secondly, the import/export system, as taught by Manucha and Melchior in the cited passages, describe maintaining and editing databases of records relating to a plurality of goods shipments in a supply chain between at least two jurisdictions, and in this way the cited prior art throughout teaches a next step for particular supply chain members. For support that these particular rolls are indicated as responsible for carrying out a next step, Manucha, paragraphs 69, wherein utilizing the databases in the way cited in the prior art, a supply chain member can initiate a new shipment with a commencement request, and after the process commences, participating parties connect to the system to transmit or modify data relating to the transaction including “delivery dates...updates on the shipment process, release information,

Art Unit: 3626

etc.” (see: Manucha, paragraph 73 and 74) including, in a specific example, a delivery manifest (see: Manucha, paragraph 76).

Claim 2

- Claim 2 Applicant response: “The summary of the Mallon PCT publication in Melchior [0008] is too brief to be meaningful. The Examiner's proper course would be to cite the Mallon reference instead of a two sentence summary, which distinguishes Melchior from the claimed teachings and strongly suggests that Mallon lacks meaningful integration.”
- Claim 2 Examiner response: Applicant’s opinion is appreciated but in absence of argument is found unpersuasive.

Claims 3 and 6

- Claims 3 and 6 Applicant response: The claims “should be allowable over Manucha et al. in view of Melchior et al. as claim 1, from which it depends.”
- Claims 3 and 6 Examiner response: Applicant’s argument is found unpersuasive as claim 1 has not been indicated as allowable.

Claim 7

- Claim 7 Applicant response: “Paragraph [0074] of Manucha, on which the Examiner relies (OA at 7), has nothing to do with this claim. Detecting excessive delay is not discussed by Manucha, either in [0074] or elsewhere.”
- Claim 7 Examiner response: Applicant’s argument is unpersuasive. The cited art teaches communications and transactions of information pertaining to updates of the shipment process utilizing the database tables inclusive of a consolidation

Art Unit: 3626

detail table, which includes estimated and actual departure, arrival, and delivery dates and times. Exactly what constitutes an "excessive delay" is not claimed; therefore, it is understood to be a value other than the estimated time in Manucha's consolidation detail table.

Claims 8-14

- Claims 8-14 Applicant response: "[T]he Examiner has not looked at the references from the perspective of an importer using the system. The interaction between the importer and a computerized system is not described anywhere in the Examiner's basis for rejection."
- Claims 8-14 Examiner response: Applicant's opinion is appreciated but in absence of argument is found unpersuasive.

Claims 15-17

- Claims 15-17 Applicant response: "[T]he Examiner has not looked at the references from the perspective of a beneficiary. The interaction between the beneficiary and a computerized system is not described anywhere in the Examiner's basis for rejection."
- Claims 15-17 Examiner response: Applicant's opinion is appreciated but in absence of argument is found unpersuasive.

Claims 18-20

- Claims 18-20 Applicant response: The claims "should be allowable over Manucha et al. in view of Melchior et al. for at least the same reasons as claims 1-7".

Art Unit: 3626

- Claims 18-20 Examiner response: Applicant's argument is found unpersuasive as claims 1-7 have not been indicated as allowable.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ROBERT SOREY** whose telephone number is (571)270-3606. The examiner can normally be reached on Monday through Friday, 8:30AM to 5:00PM (EST).

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on (571)272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. S./

Examiner, Art Unit 3626

23 October 2008

/C Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626